

Appl. No. 09/965,596
Amdt. Dated 10/02/2006
Reply to Office Action of 06/30/2006

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REMARKS

This Amendment is in response to the Office Action mailed June 30, 2006. In the Office Action, claims 1-4, 6-10 and 18-31 were rejected under 35 U.S.C. §103. Reconsideration and withdraw of the outstanding rejection in light of the amendments and remarks made herein is respectfully requested.

Request for an Examiner's Interview

Applicants respectfully request the Examiner to contact the undersigned attorney in the event that, after review of the arguments presented, the Examiner is not in full agreement that the pending claims are in condition for allowance. The undersigned attorney believes that such discussions will facilitate prosecution of the subject application. The undersigned attorney can be reached at the telephone number listed below.

Rejections Under 35 U.S.C. § 103

A. REJECTION OF CLAIMS 1-4, 6-10 AND 27-31

Claims 1-4 and 6-8, 10 and 27-31 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Brunelle (U.S. Patent No. 5,608,807) in view of Zampini (U.S. Patent No. 5,319,359). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See MPEP §2143; see also In Re Fine, 873 F. 2d 1071, 5 U.S.P.Q.2D 1596 (Fed. Cir. 1988).* Herein, the combined teachings of the cited references fail to describe or suggest all of the claim limitations.

Appl. No. 09/965,596
Amdt. Dated 10/02/2006
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With respect to independent claim 1, Applicants respectfully submit that neither Brunelle nor Zampini, alone or in combination, describes or suggests "at least one indicator light ...configured with *at least two light emitting devices enclosed within a single transparent housing to collectively output a first color and a second color wherein the first color identifies that the system is operating in a first mode where the corresponding track is able to be mixed with other tracks and the second color identifies that the system is operating in a second mode where the corresponding track is associated with an output of recorded material.*" *Emphasis added.*

Upon review of the outstanding Office Action, Applicants agree with the Examiner that Brunelle does not provide any teaching for the above-identified limitation. However, Applicants respectfully disagree with the Examiner that the final (full) paragraph within column 1 of Zampini discloses a "plurality of indicator lights configured with at least two light emitting devices enclosed within a single transparent housing." *See page 3 of the Office Action.* Rather, Zampini describes a pair of dual colored LEDs, which are formed by two different colored diodes. *See Figure 2 of Zampini.* These LEDs are not enclosed within a single transparent housing and there is no suggestion for this architectural modification. *Emphasis added.*

The above-described arguments generally apply to independent claim 6. Applicants respectfully submit that neither Brunelle nor Zampini, alone or in combination, teaches or suggests (1) activating an indicator light that includes at least two light emitting devices enclosed within a single transparent housing, or (2) adjusting a color output of the activated indicator light where the first color corresponds to a first non-transport mode of a corresponding track and the second color corresponds to a second non-transport mode. In fact, the dual colored LEDs of Zampini are controlled to identify the activation state of the LED (active, about to come active or just deactivated, etc.), and the color state of the LEDs have no correspondence to the non-transport mode as claimed.

Second, the Office Action alleges that column 4 (line 62) through column 5 (line 12) of Zampini discloses "outputting a first color and a second color wherein the first color identifies that the system is operating in a first mode where the corresponding track is able to be mixed

Appl. No. 09/965,596
Amdt. Dated 10/02/2006
Reply to Office Action of 06/30/2006

with other tracks and the second color identifies that the system is operating in a second mode where the corresponding track is associated with an output of recorded material." *See Page 3 of the Office Action.* Applicants respectfully submit that it is impermissible to rely on the language in the claims as support for the teachings of Zampini. The scope of a patent's claims determines what infringes a patent; it is no measure of what it discloses. *In re Benno*, 768 F2d 1340, 226 USPQ 683, 686 (Fed.Cir.1985). Thus, the rejection is impermissible. It is respectfully requested that the Examiner identify the specific areas in the specification where Zampini describes those alleged limitations.

With respect to dependent claims 2-4 and 8-10, the Office Action states these claims are rejected because Brunelle discloses that identification information could be changed as necessary. *See page 4 of the Office Action.* Applicants respectfully traverse the rejection of these dependent claims because a *prima facie* case of obviousness has not been established. Herein, Brunelle includes a passage that "the identification information in the display panel 18 is changed as necessary and at any time with very little trouble to the audio engineer." *See Col. 5, lines 39-42 of Brunelle.* This "identification information" is directed to indicia for identifying each instrument or sound to a channel module in connection with each piece of music or sound recording being mixed. It is not directed to an operation for identifying a mode of a corresponding track as claimed.

In addition, based on the dependency of claims 2-4 and 8-10 on independent claims 1 and 6, believed by Applicants to be in condition for allowance, no further discussion as to the grounds for traverse is warranted. Applicants reserve the right to present such arguments in an Appeal is warranted. Withdrawal of the §103(a) rejection as applied to claims 2-4 and 8-10 is respectfully requested.

As a result, Applicants respectfully submit that the outstanding §103(a) rejection as applied to independent claims 1-4, 6-10 and 27-31 be withdrawn.

B. REJECTION OF CLAIMS 18, 19, 21, 24 AND 25

Appl. No. 09/965,596
Amdt. Dated 10/02/2006
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Claims 18, 19, 21, 24 and 25 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Brunelle in view of Turnbull (U.S. Patent No. 5,803,579). Applicants respectfully disagree with the rejection because a *prima facie* case of obviousness has not been established. Neither Brunelle nor Turnbull, alone or in combination, suggests an operation of determining a *type of transport movement* of the track in the multi-track recording system as well as indicating the *type of transport movement* of the track by illuminating a first light emitting diode disposed in a housing. *Emphasis added.*

Even in accordance with the Examiner's interpretation that the output meter (4) of Brunelle constitutes the first light emitting device (LED) and the instrumental indicator (18) of Brunelle constitutes the second LED, the claimed invention is not suggested by the combined teachings of the cited references. For instance, the teachings of the output meter (4) and the instrumental indicator (18) of Brunelle combined with the particular lighting pattern of two separate LED groupings of Turnbull would not result or even suggest lighting elements for indicating the *mode* of the track and/or type of transport movement. *Emphasis added.* Rather, the output meter (4) as described by Brunelle (LEDs) is used to identify the level of audio sound for a channel module (2). The instrumental indicator (18) is an LCD that displays changeable information, such as text to identify instrument type. The combined teaching of the cited references does not suggest at least two LEDs (first and second LEDs) disposed in a housing in order to generate a third color when both are activated (claim 18) or indicate a type of transport movement (claim 20) as claimed.

Applicants respectfully submit that the LED groupings of Turnbull feature complementary LED lighting that, when combined, produces white light that can be used for a number of applications such as an automotive maplight. The white light is used strictly for illumination, and is not used for indicating a mode of a track in the multi-track recording system as claimed. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination. *See In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).*

Appl. No. 09/965,596
Amdt. Dated 10/02/2006
Reply to Office Action of 06/30/2006

Therefore, Applicants respectfully submit that independent claim 18 is allowable and withdrawal of the outstanding §103(a) rejection is respectfully requested.

With respect to claim 21, Applicants respectfully submit that the §103(a) rejection appears to be an improper rejection because claim 21 is dependent on claim 20, but different references are used in support of this §103(a) rejection. In fact, the cited references are distinct from the reference recited in the §103(a) rejection of claim 20.

Moreover, with respect to claim 19 and claims 21, 24 and 25, these claim sets are dependent on independent claim 18 and 20, respectively. Applicants believe that claims 18 and 20 are in condition for allowance as noted above. Therefore, no further discussion as to the grounds for traverse is warranted. Applicants reserve the right to present such arguments if an Appeal is warranted.

In view of the foregoing arguments, Applicants respectfully request withdrawal of the §103(a) rejection of claims 18, 19, 21, 24 and 25.

C. REJECTION OF CLAIMS 20 AND 22

Claims 20 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Zampini. Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established because Zampini does not describe or suggest the *type of transport movement and a mode of the one corresponding track*. *Emphasis added*. Rather, Zampini teaches the illumination of the line out LEDs (L,R of FIG. 2) when the mixer routes the edit signals to the line out channels. *See col. 3, lines 1-2 and 48-49 of Zampini*. Such illumination clearly fails to indicate the type of transport movement of the track as set forth in claim 20 and further defined in dependent claim 22.

The mere statement in Zampini that the "features of the invention are equally applicable with respect to other types of control of a mix or cross fade operation" does not suggest that the dual colored LEDs will convey a monitored status of one corresponding track of the plurality of recording tracks, where the monitored status indicates both a type of transport movement and a mode of the one corresponding track. Rather, this statement merely suggests that the LEDs can

Appl. No. 09/965,596
Amdt. Dated 10/02/2006
Reply to Office Action of 06/30/2006

OCT 02 2006

be used to identify that the channel is active, inactive, or not involved in any current mix or cross fade. *See col. 1, line 65 to col. 2, line 4 of Zampini.*

Hence, Applicants respectfully request withdrawal of the §103(a) rejection as applied to claims 20 and 22.

D. REJECTION OF CLAIM 23

Claim 23 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Brunelle in view of Zampini (U.S. Patent No. 5,444,789). Applicants respectfully traverse the rejection. However, it is noted that claim 23 is dependent on claim 20, which Applicants believe is in condition for allowance. Therefore, no further discussion as to the grounds for traverse is warranted.

Withdrawal of the §103(a) rejection as applied to claim 23 is respectfully requested.

D. REJECTION OF CLAIM

Claim 26 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Zampini as applied to claim 20 and in view of Brunelle (5,608,807). Applicants respectfully traverse the rejection. However, it is noted that claim 26 is dependent on claim 20, which Applicants believe is in condition for allowance. Therefore, no further discussion as to the grounds for traverse is warranted.

Withdrawal of the §103(a) rejection as applied to claim 26 is respectfully requested.

Appl. No. 09/965,596
Amdt. Dated 10/02/2006
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Conclusion

In view of the remarks made above, it is respectfully submitted that pending claims 1-4, 6-10 and 18-31 define the subject invention over the prior art of record. Thus, Applicants respectfully submit that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: October 2, 2006

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